

REMARKS

Applicant has carefully studied the Office Action of June 15, 2005, and offers the following remarks to accompany the above amendment.

Initially, Applicant cancels claim 59 as drawn to a non-elected species. Applicant reserves the right to pursue the subject matter of claim 59 in a divisional application. However, this amendment simplifies issues for the moment. The remaining withdrawn claims remain in the application because the generic claims from which they depend are still pending.

Claims 1, 15, 16, 19-22, and 58 were rejected under 35 U.S.C. § 103 as being unpatentable over Lee et al. (hereinafter "Lee") in view of Terahara et al. (hereinafter "Terahara"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, there must be some suggestion to combine the references. To establish a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Federal Circuit has imposed the requirement to use actual evidence to help combat the powerful lure of hindsight reconstruction. *Id.* While acknowledging that the range of sources from which the Patent Office may find the evidence is broad, the Federal Circuit reiterated that the breadth of available sources does not diminish the requirement for actual evidence. *Id.*

Even if the combination is properly made, to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the combination. MPEP § 2143.03.

The Patent Office has not properly supported the motivation to combine Lee and Terahara. Specifically, the Patent Office opines that the motivation to combine the references is "...to adjust the power level of each optical channel based on the detected power level of each plurality of attenuated optical signal so as to equalize the power in each of the plurality of optical channel." (Office Action of June 15, 2005, page 3, lines 19-22). This asserted motivation lacks the evidence required by the Federal Circuit. As such, the motivation to combine the references is improper. Since the motivation to combine the references is improper, there is no suggestion to combine the references. Since there is no suggestion to combine the references, the combination is improper. Since the combination is improper, and the references individually do

not establish obviousness, the rejection is improper. Since the rejection is improper, the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 1, 15, 16, 19-22, and 58 at this time.

Even if the combination is properly supported, a point which Applicant does not concede, the combination does not establish *prima facie* obviousness because certain elements are not shown. For example, claim 1 recites a plurality of splitters each being connectable to an output of a respective one of the wavelength division multiplexers. The Patent Office has identified Lee element 540 as the multiplexers and element 536 as the splitter. However, element 536 is part of an optical power regulating device 530 (see Lee, col. 5, lines 20-23). As is readily seen in Lee, Figure 5A, element 530 is positioned in front of element 540, and thus, the element 536 is not connected to an output of the multiplexer as recited in the claim. Likewise, the Patent Office has identified Lee element 538 as the equalizer. The claim recites that the equalizer be connected to the splitter and the VOIC. As is readily seen in Lee, Figure 5C, element 538 is not connected to the splitter. Lee element 538 is connected to element 535 (which the Patent Office has identified as a VOIC) and element 537 (a photodiode, which the Patent Office has not used in the rejection). Lee's element 538 is clearly not connected to the element 536 and thus does not show the claimed arrangement. Nothing in Terahara cures the deficiency of Lee. Thus, in combination, the two references do not teach or suggest the claim element. Since the combination does not teach the claim element, the combination does not establish obviousness. This provides an independent reason why the claims are allowable.

Claims 2, 3, 23, and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Lee in view of Terahara, and further in view of Taylor et al. (hereinafter "Taylor"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

Applicant initially traverses the rejection of claims 2, 3, 23, and 24 because the underlying combination of Lee and Terahara is improper as explained above. The Patent Office provides no new analysis as to why Lee would be combined with Terahara, so the combination of these two references remains improper. Since this combination is improper, this provides a first reason why claims 2, 3, 23, and 24 are allowable.

Applicant also traverses the rejection because Taylor does not cure the deficiencies of Lee and Terahara regarding the arrangement of the splitter and the equalizer. Thus, in

combination, the three references do not establish obviousness, and this provides a second reason why claims 2, 3, 23, and 24 are allowable.

Applicant further traverses the rejection of claims 2, 23, 23, and 24 because the motivation to combine Taylor is improper. Specifically, the Patent Office opines that the motivation to combine Taylor into the system of Lee and Terahara is "...for adjusting or controlling the signal intensity so that the received powers are substantially equal." (Office Action of June 15, 2005, page 4, lines 19-21). Again, this motivation is not supported by the evidence that the Federal Circuit requires. As such, the motivation to combine the references is improper. Since the motivation to combine the references is improper, there is no suggestion to combine the references. Since there is no suggestion to combine the references, the combination is improper. Since the combination is improper, and the references individually do not establish obviousness, the rejection is improper. Since the rejection is improper, this provides a third independent reason why the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 2, 3, 23, and 24 at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The references are not properly combinable and the combination does not teach or suggest the claimed invention. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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Respectfully submitted,

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